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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,961	01/30/2004	Jeffrey A. Kramer	1.091-B.03	4550

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EXAMINER

MULLER, BRYAN R

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,961

Applicant(s)

KRAMER ET AL.

Examiner

Bryan R Muller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) 1 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the compartment structured to contain extra staples of clam 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities: The first occurrence of the word, "a" in line 9 of page 1 should be replaced with "an" and the word "and" should be added between the words "segment" and "said" in line 13 of page 11.

Appropriate correction is required.

3. Claim 12 is objected to because of the following informalities: The phrase, "one of" should be deleted from line 3 of claim 12 (line 1, page 13). Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Ackeret (PCT Pub. WO97/04924, US equivalent 6,286,745 provided).

6. Ackeret discloses a stapler comprising a pair of stapler arms (20, 22) pivotally secured in confronting relation with one another and structured to pass a staple through an item positioned there between; an opener segment (83 in Figs. 6 and 8) extending from one of said stapler arms; a blade (edge of 83) disposed adjacent said opener segment; and said opener segment structured to be introduced at least at a fold defined

by a closure flap of an envelope until the envelope engages said blade and is cut thereby.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (D186,088) in view of Cheldin (5,875,503).

9. In reference to claim 1, Schwartz discloses a stapler comprising a pair of arms pivotally secured in confronting relation with one another, one of said arms containing a plurality of staples and structured to dispense one of said staples towards said other arm upon being pivotally moved towards said other arm and meeting resistance, a opener segment extending along at least a portion of a length of one of said arms, said opener segment including a proximal end and a distal end, said proximal end secured to said one of said arms, and said opener segment at least partially tapering towards said distal end, said distal end being structured to be introduced at least at a fold defined by a closure flap of an envelope until the envelope engages said blade and is cut thereby. Schwartz, however, fails to disclose that there is a blade disposed between said opener segment and said arm to which it is secured, at generally said proximal end of said opener segment. Cheldin discloses a combination staple remover and letter opener,

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the staple remover having a similar structure to a stapler with the pair of arms (20 and 40) pivotally secured in confronting relation with one another. The Schwartz application provides the combination of a stapler and a letter opener, but the letter opener of the Schwartz invention appears to be very unsafe to the user, providing an exposed point and blade and is much larger making it less convenient to use, store and transport, where as the letter opener of Cheldin is much safer because it does not protrude like the Schwartz letter opener and the sharp blade is protected from the contact of a users hand or fingers and is much more compact to increase the ease of use, storage and transport. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the letter remover on the stapler of Schwartz with the latter remover of Cheldin, thus providing a safe and convenient combination stapler and letter opener. The alteration of the Schwartz invention in view of Cheldin would thus provide a stapler comprising a pair of arms pivotally secured in confronting relation with one another, one of said arms containing a plurality of staples and structured to dispense one of said staples towards said other arm upon being pivotally moved towards said other arm and meeting resistance, an opener segment (200 of Cheldin) extending along at least a portion of a length of one of said arms, said opener segment including a proximal end (64 of Cheldin) and a distal end (203 of Cheldin), said proximal end secured to said one of said arms, a blade (204 of Cheldin) disposed between said opener segment and said arm to which it is secured, at generally said proximal end of said opener segment and said opener segment at least partially tapering towards said distal end, said distal end being structured to be introduced at

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least at a fold defined by a closure flap of an envelope until the envelope engages said blade and is cut thereby.

10. In reference to claim 2, the letter opener of Cheldin has the blade angled towards the distal end of the opener segment.

11. In reference to claim 3, the distal end of the letter opener of Cheldin defines a point.

12. In reference to claim 4, both Schwartz and Cheldin disclose that the bottom of the opener segment is generally co-planar with the bottom of the arm to which it is secured so it would be obvious that the bottom of the opener segment should be attached generally co-planar with the bottom of the arm to which it is secured.

13. In reference to claim 5, both Schwartz and Cheldin disclose that the opener segment is generally co-planar with the arm to which it is secured so it would be obvious that the opener segment should be attached generally co-planar with the arm to which it is secured.

14. In reference to claim 6, the stapler of Schwartz includes first ends as recited in claim 1 wherein said arms pivotally secured to one another, and second ends which move toward and away from one another as a result of said pivotal securing at said first ends.

15. In reference to claim 7, Cheldin discloses that the proximal end of said opener segment is secured generally at said second end of one of said arms but this arrangement is a matter of design choice and the letter opener would function exactly the same if the proximal end of said opener segment is secured generally at said first

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end of one of said arm and it would have been obvious to attach the proximal end of the opener segment to the first end of one of the arms of the Schwartz stapler because this would arrange the opener such that the distal end is pointed forward, similar to the distal end of the Schwartz letter opener, and this would prevent pointed distal end from stabbing or poking the operators hand during stapling and the stapler and letter opener would operate in the same direction so the operator would not need to reposition the device to use one or the other.

16. In reference to claim 8, the arrangement of the opener segment of Cheldin on the stapler of Schwartz, as discussed in reference to claim 7 above, would be such that the distal end of said opener segment extends towards said second end of one of said arms.

17. In reference to claim 9, the stapler of Schwartz comprises a first arm structured to contain and dispense said staples, and a second arm against which said staples are dispensed.

18. In reference to claim 10, Schwartz discloses that the letter opener is secured to the second arm and both arms of Cheldin are essentially the same, thus, it would have been obvious to secure the opener segment to the second arm as disclosed by Schwartz.

19. In reference to claim 11, Schwartz discloses that the second arm includes a first end pivotally secured to said first arm, and a second end at which engages dispensed staple.

20. In reference to claim 12, as discussed supra, it would have been obvious to secure the proximal end of the opener segment to the first end of the second arm.

21. In reference to claim 13, as discussed supra, it would have been obvious to secure the proximal end of the opener segment such that the distal end extends towards the second end of the second arm.

22. In reference to claim 14, as discussed supra, the blade is angled towards the distal end of the opener segment.

23. In reference to claim 15, as discussed supra, the distal end defines a point.

24. In reference to claim 16, as discussed supra, it would have been obvious that the bottom of the opener segment should be attached generally co-planar with the bottom of the arm to which it is secured, which is the second arm, also discussed supra.

25. In reference to claim 17, as discussed supra, it would have been obvious that the opener segment should be attached generally co-planar with the arm to which it is secured, which is the second arm, also discussed supra.

26. In reference to claim 20, both Schwartz and Cheldin disclose that the opener segment and the arm to which it is secured are integrally formed with one another, therefore, it would have been obvious to make the opener segment of Cheldin and the stapler arm of Schwartz integrally formed with one another.

27. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (D186,088) in view of Cheldin (5,875,503) as applied to claim 10 and further in view of Evans et al (5,690,268).

28. Evans discloses a stapler with a compartment structure (145) in a second arm to contain extra staples and a wedge element (136) extending from a first end of the second arm to remove staples. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the stapler of Schwartz in the combination of the Schwartz and Cheldin inventions to make the tool even more useful in that one tool could then staple objects together, open letters and remove staples and the compartment would have ensured that the operator does not run out of staples as quickly as a stapler without storage for additional staples.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vaught (5,720,062) discloses the combination of a letter opener and staple remover, Cheldin (6,163,910) discloses the combination of a letter opener and staple remover mounted on another tool, Crofoot (1,663,242) discloses the addition of a staple storage area to a second arm of a stapler and Mitsuhashi discloses the addition of a staple puller to a stapler.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan R Muller whose telephone number is (571) 272-4489. The examiner can normally be reached on Monday thru Thursday and second Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J Hail III can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BRM BRM
5/24/2005



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